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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,515	02/04/2000	Howard G. Page	1285	8911
28004	7590	09/06/2012	EXAMINER	
SPRINT			RETTA, YEHDEGA	
6391 SPRINT PARKWAY			ART UNIT	PAPER NUMBER
KSOPHT0101-Z2100			3622	
OVERLAND PARK, KS 66251-2100				

MAIL DATE	DELIVERY MODE
09/06/2012	PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

6

7

8 *Ex parte* HOWARD G. PAGE,
9 MIKE O'BRIEN,
10 and JAY CEE STRALEY

11

12

13 Appeal 2011-008572
14 Application 09/498,515
15 Technology Center 3600

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18 Before LINDA E. HORNER, ANTON W. FETTING, and
19 MEREDITH C. PETRAVICK, *Administrative Patent Judges.*
20

21 FETTING, *Administrative Patent Judge.*

22 DECISION ON APPEAL

23

1 STATEMENT OF THE CASE¹

2 Howard G. Page, Mike O'Brien, and Jay Cee Straley (Appellants) seek
3 review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1, 5, 7, 8,
4 10-12, 17, 18, 20, and 21, the only claims pending in the application on
5 appeal.² We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
6 (2002).

7 The Appellants invented a video advertising system that selects and
8 inserts video advertising into the video content of a video-on-demand
9 system. (Specification 2:14-16). The invention selects video advertising for
10 individual target viewers based on their viewer profile and their video
11 content selection (Specification 3:13-15). The video advertising insertion
12 system (1) receives a video stream carrying selected video content from a
13 video-on-demand system, (2) selects and inserts video advertising into the
14 video stream, and (3) transfers the video stream carrying both the selected
15 video content and the selected video advertising for display to a target
16 viewer. (Specification 3:18-23).

17 An understanding of the invention can be derived from a reading of
18 exemplary claim 1, which is reproduced below [bracketed matter and some
19 paragraphing added].

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.", filed December 13, 2010) and Reply Brief ("Reply Br.", filed April 28, 2011), and the Examiner's Answer ("Ans.", mailed February 28, 2011).

² The Board issued a prior decision in the present application in Appeal 2007-1333 on November 6, 2007.

1 1. A method

2 for providing video advertising
3 where a video-on-demand system receives a request from
4 a target viewer for selected video content,
5 and in response,
6 transfers the selected video content in a video
7 stream to the target viewer,

8 the method comprising:

- 9 [1] selecting video advertising
10 that has a subject matter relation
11 to the selected video content
12 requested by the target viewer;
13 [2] determining an insertion point
14 in the selected video content
15 for the selected video advertising,
16 wherein the insertion point comprises
17 data indicating where
18 in the selected video content
19 the selected video advertising is to be
20 inserted;

- 21 [3] transferring the selected video content

22 to a target viewer device
23 over a first transport system

24 and
25 transferring the selected video advertising
26 to the target viewer device
27 over a second transport system,
28 wherein the first transport system uses greater
29 bandwidth for video transfer

than the second transport system;

[4] transferring the insertion point

to the target viewer device

over the second transport system;

[5] storing the selected video advertising

in video storage

of the target viewer device;

[6] transferring the selected video content

in the video stream

from the target viewer device

to a display device;

[7] interrupting the transferring

of the selected video content

in the video stream

at the insertion point;

[8] retrieving the selected video advertising

from the video storage;

[9] inserting the selected video advertising

into the video stream;

[10] resuming the transferring of the selected video content

in the video stream

at the insertion point;

and

[11] disabling fast-forward capability

when the selected video advertising is displayed.

1 The Examiner relies upon the following prior art:

Farmer	US 5,822,018	Oct. 13, 1998
Eyer	US 6,588,015 B1	Jul. 1, 2003
Zigmond	US 6,698,020 B1	Feb. 24, 2004
Swix	US 6,718,551 B1	Apr. 6, 2004

"NDS: NDS' XTV(TM) time shifting technology empowers th[e] viewer and the broadcaster". M2 Presswire, Sep. 10, 1999.

4 Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected under
5 35 U.S.C. § 103(a) as unpatentable over Swix, Farmer, Zigmond, XTV, and
6 Ever.

ISSUES

8 The issues of obviousness turn primarily on whether the Examiner
9 presented articulated reasoning with rational underpinnings to transfer
10 Swix's video content and insertion data over separate transport systems as
11 required by limitations [2]-[4].

FACTS PERTINENT TO THE ISSUES

13 The following enumerated Findings of Fact (FF) are believed to be
14 supported by a preponderance of the evidence.

15 *Facts Found in the Prior Decision.*

1 and incorporated by reference.³

2 *Farmer*

- 3 01. Farmer is directed to normalizing signal levels in a signal
4 processing system. (Farmer, col. 1, ll. 8-10.)
- 5 02. In many prior art CTV systems, ad-insertion is handled by a
6 combination of cue tone detectors, switching equipment and tape
7 players which hold the advertising material. Upon receipt of the
8 cue tones, a CTV insertion controller automatically turns on a tape
9 player containing the advertisement. Switching equipment then
10 switches the system output from the video and audio signals
11 received from the programming source to the output of the tape
12 player. When switched, these successive program and advertising
13 segments usually feed to a radio-frequency (RF) modulator for
14 delivery to the subscribers. (Farmer, col. 1, ll. 37-51.)
- 15 03. In addition to the video and audio channels, Farmer's receiver
16 transmits cue tones on line 23 to ad-insertion system 24 which
17 uses the cue tones to generate timing signals for controlling the
18 insertion of advertising into the program material. When operated,
19 switch 25 routes either the program audio and video, which appear
20 on lines 22, or the advertising video and audio, which appear on
21 lines 27, to modulator 30 via lines 33. Modulator 30 modulates the
22 video and audio onto an RF carrier that it transmits to subscribers

³ The prior Board decision made findings of fact pertaining to claim construction of "transport" and "transport system" and the scope and content of Swix, Eyer, and XTV.

along with all other channels via combiner 28. (Farmer, col. 4, ll. 25-48.)

Zigmond

04. Zigmund is directed to displaying advertisements to viewers of video programming by selecting and inserting advertisements into a video programming feed at the household level. (Zigmund, col. 1, ll. 8-12)

ANALYSIS

9 This is the second time this application has come before the Board. In
10 the prior appeal, the Board panel affirmed the rejection of the claims then
11 pending in the application as being unpatentable over Swix, Eyer, and XTV.
12 As we stated *supra*, the invention inserts ads into a video stream. The
13 primary reference applied, Swix, does this by inserting tones in the video
14 stream that mark where ads are to be inserted. The video stream, containing
15 tone markers, is transmitted separately from the ads, and the two are merged
16 after transmission. Limitation [2] as drafted at the time of the Board's prior
17 decision essentially recited this, and the panel affirmed the Examiner's
18 rejections.

19 Subsequent to the prior appeal, Appellants added limitations that: altered
20 the insertion in limitation [2] to a determination of an insertion point; added
21 the wherein clause to limitation [2]; changed the object of the limitation [3]
22 transfers from a target viewer to a target viewer device; and added
23 limitations [4] through [10]. As a result, the Examiner now applies two
24 additional references, *viz.* Farmer and Zigmond.

1 In particular, because limitation [2] now determines an insertion point
2 rather than simply inserting the advertisement, and recites that the insertion
3 point comprises data, and limitation [4] transfers the insertion point data
4 over the transport system not used for the video content, Swix no longer
5 describes the insertion as claimed. Swix embedded the insertion points in
6 the video content precluding their transmission separate from the video
7 content.

8 Farmer describes a satellite system feeding a cable TV system for
9 broadcasting video content. Farmer has facial similarity to the claim, in that
10 it transmits cue tones separate from the video content to the cable operator to
11 show where to insert ads. The similarity falters because Farmer does so
12 prior to transmission from the cable operator to viewer. The claim limitation
13 [3] requires transferring content and ads separately to the target viewer
14 device over the two transport systems.

15 By the time the video in Farmer is transmitted to the viewer, the merge
16 has already occurred, apparently different from limitation [3]. Farmer does
17 this for at least the reason that Farmer is manipulating analog signals,
18 requiring expensive special purpose equipment, contrasted with Swix and
19 the claimed subject matter using digital data signals. Viewers are unlikely to
20 invest in such equipment for the benefit of the advertisers.

21 The Examiner attempts to clear this hurdle by construing the word
22 “over” to not require complete coverage. Ans. 8. That is, so long as any of
23 the signal transports occur separately, each is transferred over those separate
24 transports on their way to the target viewer. While such a construction may
25 be creative, it lands the Examiner on a paradox, for limitation [4] still

1 requires that the insertion point data arrive at the viewer device. Farmer's
2 insertion data disappears with the merge process. The Examiner attempts to
3 clear this hurdle by going back to Swix, suggesting one of ordinary skill
4 would postpone the merge until the data reached the viewer. Ans. 4-5.

5 This essentially is the crux of two of Appellants' arguments. The first
6 argument is that

7 [o]nly a single transport system exists between Farmer CTV
8 System 20 and the target viewer devices. Therefore, it is not
9 possible for Farmer to teach *transferring the insertion point to*
10 *the target viewer device over the second transport system* as
11 asserted in the Final Office Action because Farmer does not
12 have a second transport system which links CTV System 20 to
13 the target viewer devices. The Farmer timing signals and video
14 content are combined at Switch 25 and transmitted to the target
15 viewer devices over **a single transport system**.

16 Appeal Br. 6-7. The second argument is that the

17 purported motivation for combining Farmer with Swix is "in
18 order for a local program to control the insertion point of the
19 local advertisements" (pg. 3, lines 7-8). However, this
20 motivation would not lead to use of Farmer. In Farmer, the Ad-
21 Insertion System and the switching and modulating functions
22 which combine the advertising material with the program
23 material are located in the centralized distribution equipment of
24 the cable television system (figs. 1 and 3). The advertisements
25 are inserted into the program material before it is transmitted to
26 the cable distribution system (fig. 1). Therefore, **Farmer does**
27 **not teach or suggest allowing "a local program to control**
28 **the insertion point of the local advertisements"** as stated in
29 the Final Office Action.

30 Appeal Br. 8. Thus, one way or another, Farmer does not describe limitation
31 [4] and the Examiner's attempt to provide Swix as motivation to carry the
32 insertion data to the viewer device fails because, while Swix does indeed

1 show deferring insertion until signal arrival at the viewer device, Swix
2 embeds the insertion data in the video content.

3 The Examiner attempts to clear this hurdle by introducing Zigmond,
4 which does indeed merge an ad into video content at the viewer device based
5 on a trigger signal separate from the video content. But Zigmond obtains the
6 trigger data from the video content at the viewer device to do so. Zigmond
7 does not support the Examiner's theory of keeping the insertion data
8 separate from the video content during transmission. To the extent the
9 Examiner is relying on Farmer's transmission from the satellite to the cable
10 operator for such separate transmission, again, this would not apply in the
11 digital domain of Swix and Farmer. Thus, we agree with Appellants that the
12 Examiner failed to articulate a reason with rational underpinning to transfer
13 Swix's video content and insertion data over separate transport systems.

14 The only remaining independent claim, claim 12, has comparable
15 limitations.

16 CONCLUSIONS OF LAW

17 The rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 under
18 35 U.S.C. § 103(a) as unpatentable over Swix, Farmer, Zigmond, XTV, and
19 Eyer is improper.

20 DECISION

21 The rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 is
22 reversed.

23 REVERSED

24 JRG